

### Remarks

The Office Action mailed March 1, 2005, and made final, has been carefully reviewed and the foregoing amendment has been made in consequence thereof.

Claims 1-16 are pending in this application. Claims 1-16 stand rejected.

The rejection of Claim 2 under 35 U.S.C. § 112, second paragraph, is respectfully traversed. More specifically, Claim 2 has been amended to recite “wherein *at least one substantially open-topped shipping tray of said at least two substantially open-topped shipping trays* is fabricated from corrugated paperboard material.” Accordingly, Claim 2 is submitted as satisfying the requirements of Section 112, second paragraph. For at least the reasons set forth above, Applicants respectfully request the Section 112 rejection of Claim 2 be withdrawn.

The rejection of Claims 1-12 and 14-16 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,390,847 (Young) or U.S. Patent No. 6,354,487 (Muisse) in view of U.S. Patent No. 6,050,419 (Flanagan), U.S. Patent No. 6,227,779 (Bullock), and U.S. Patent No. 4,865,202 (Day) is respectfully traversed.

Young describes a fruit and product container 10 having a bottom 12 and two side walls 14 formed of a common piece of corrugated cardboard. The container 10 also has two end walls 16 formed of laminated paperboard attached to the bottom 12 and side walls 14 to define a box. The two laminated paperboard end walls 16 may enhance a stacking strength and moisture resistance of the container 10. A top 18 may be removably attached to stacking alignment tabs 22 that extend upwardly from the end walls 16.

Muisse describes a combined stacking tab for use with a container having a containment portion 30 and a lid 20. The containment portion 30 includes a lateral panel 32 and an upright wall 34. The upright wall 34 includes an upper edge 36 with a stacking tab 38. The lid 20 also includes a lateral panel 22 and an upright wall 24 connected to the lateral panel 22. A lid stacking tab 26 is cut from portions of the lid lateral panel 22 at its connection to the lid upright wall 24, thereby resulting in an opening 28 in the lid lateral panel 22. As erected, the lid stacking tab 26 remains in the plane of the lid upright wall 24,

with the containment portion stacking tab 38 being located within the opening 28 of the lid lateral panel 22. The combination of the containment portion stacking tab 38 and the lid stacking tab 26 forms a combined stacking tab of at least one double-ply material thickness.

Flanagan describes an adjustable-length, reusable, recyclable pallet wrap 10 for constraining a lading while displaying high-impact graphics. The pallet wrap 10 preferably has a set of horizontally-spaced, vertically oriented, preformed lines 32 of reduced resistance to bending at each of four regions to facilitate providing a snug fit around typical pallets 12 or loadings of various sizes. In one embodiment, a dual-function pallet wrap 10 is provided which can function as a pallet skirt for in-store displays in addition to functioning as a constraint for the lading.

Bullock describes a load restraint method for securing cargo within transport containers such as intermodal containers 10. First and second load restraining strips 24 include an adhesive coating 30 on one surface of the strips for adherence to sidewalls 26 of an intermodal container 18. Tape 28, 100 may be used to secure strips 24 to the load 22.

Day describes a mobile extra display module 10 for storing, transporting, and displaying a quantity of containers 12. The module 10 includes a pallet base 14 and a plurality of alternating layers of tier sheets 18 and containers 12. The tier sheets 18 have a top surface 24 with an array of tope recesses 28 for receiving container bottoms, and a bottom surface 26 with an array of bottom recesses 30 for receiving container tops. For storage and transportation purposes, the display module 10 includes a rigid lid 42 and a pair of straps 44 extending around the module 10, over the lid 42, and under the base 14. The straps 44 are under a high force of about 100 pounds for holding the display module 10 together.

Claim 1 recites a shipping system for the facilitated packing and transportation of items, wherein the items are of a type requiring separation between vertically stacked layers, and the shipping system comprises “at least one shipping unit, each shipping unit further comprising...at least two substantially open-topped shipping trays...each tray having a top, two opposing sides and a bottom...a cover...and at least one binding member...wherein the binding member comprises at least one strip of adhesive material, simultaneously engaging a

top surface of the cover and a bottom surface of a bottom-most one of said at least two substantially open-topped shipping trays....”

None of Young, Muise, Flanagan, Bullock, or Day, considered alone or in combination, describe or suggest all of the recitations of Claim 1. For example, none of Young, Muise, Flanagan, Bullock, or Day, considered alone or in combination, describe or suggest a shipping system including at least two substantially open-topped shipping trays, a cover, and at least one binding member, wherein the binding member comprises at least one strip of adhesive material, simultaneously engaging a top surface of the cover and a bottom surface of a bottom-most one of said at least two substantially open-topped shipping trays. Rather, as admitted on page 3 of the Office Action, neither Young nor Muise describe or suggest a binding member. None of Flanagan, Bullock, or Day make up for the deficiencies of Young and Muise. Rather, Flanagan describes a pallet wrap that is wrapped around the sides (but not the top or bottom) of a plurality of articles on a pallet; Bullock describes a load restraint method wherein tape secures restraining strips to a box by adhering to a side and a portion of a top of a box, but the tape does not adhere to a bottom of the box; and Day describes a mobile extra display module wherein a pair of straps extend around the module, over a lid of the module, and under a base of the module, but are not adhered to the module. Accordingly, none of Flanagan, Bullock, or Day describe or suggest a shipping system including at least two substantially open-topped shipping trays, a cover, and at least one binding member, wherein the binding member comprises at least one strip of adhesive material, simultaneously engaging a top surface of the cover and a bottom surface of a bottom-most one of said at least two substantially open-topped shipping trays. Indeed, both Bullock and Day teach away from the present invention. For example, Bullock teaches that the tape is adhered over the restraining straps after the boxes are positioned in the container, therefore possibly making it difficult to adhere the tape to a bottom of the boxes; and Day teaches that the straps are under a high force of about 100 pounds for holding the display module together.

Because none of Young, Muise, Flanagan, Bullock, or Day teaches or suggests one or more of the claimed elements, it follows that a combination of Young, Muise, Flanagan,

Bullock, and Day cannot teach or suggest those elements. Accordingly, Claim 1 is submitted to be patentable over Young or Muise in view of Flanagan, Bullock, and Day.

Claims 2-12 and 14-16 depend, directly or indirectly, from independent Claim 1. When the recitations of Claims 1-12 and 14-16 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2-12 and 14-16 likewise are patentable over Young or Muise in view of Flanagan, Bullock, and Day.

Additionally, Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. Obviousness cannot be established by merely suggesting that it would have been obvious to one of ordinary skill in the art to modify Young or Muise with Flanagan, Bullock, and Day. As explained by the Federal Circuit, “to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Applicant.” In re Kotzab, 54 USPQ2d 1308, 1316 (Fed. Cir. 2000). MPEP 2143.01.

Furthermore, as is well established, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 221 U.S.P.Q.2d 1125 (Fed. Cir. 1984). Furthermore, the Federal Circuit has determined that:

[I]t is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” In re Fitch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

Further, under Section 103, “it is impermissible . . . to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” In re Wesslau, 147 USPQ 391, 393 (CCPA 1965). Rather, there must be some suggestion, outside of Applicants’ disclosure, in the prior art to combine such

references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants' disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to combine the cited art, nor any reasonable expectation of success has been shown.

Accordingly, since there is no teaching nor suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection of Claims 1-12 and 14-16 be withdrawn.

For at least the reasons set forth above, Applicants respectfully request that the 35 U.S.C. §103(a) rejection of Claims 1-12 and 14-16 be withdrawn.

The rejection of Claim 13 under 35 U.S.C. § 103(a) as unpatentable over Young or Muise in view of Flanagan, Bullock, and Day, and further in view of Presentation Brochure, "Corrugated Common Footprint for Product Packaging, Kroger, September 13, 2000", by Fibre Box Association (Corrugated Common Footprint) is respectfully traversed.

Young, Muise, Flanagan, Bullock, and Day are described above.

Claim 13 depends from independent Claim 1, which is recited above. None of Young, Muise, Flanagan, Bullock, Day, or Corrugated Common Footprint, considered alone or in combination, describe or suggest all of the recitations of Claim 1. For example, as discussed above, none of Young, Muise, Flanagan, Bullock, or Day, considered alone or in combination, describe or suggest a shipping system including at least two substantially open-topped shipping trays, a cover, and at least one binding member, wherein the binding member comprises at least one strip of adhesive material, simultaneously engaging a top surface of the cover and a bottom surface of a bottom-most one of said at least two substantially open-topped shipping trays. Corrugated Common Footprint does not make up for the deficiencies of Young, Muise, Flanagan, Bullock, and Day. Because none of Young, Muise, Flanagan, Bullock, Day, or Corrugated Common Footprint teach or suggest one or more of the claimed elements, it follows that a combination of Young, Muise, Flanagan, Bullock, Day, and

Corrugated Common Footprint cannot teach or suggest those elements. Accordingly, Claim 1 is submitted to be patentable over Young or Muise in view of Flanagan, Bullock, and Day, and further in view of Corrugated Common Footprint.

Claim 13 depends from independent Claim 1. When the recitations of Claim 13 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claim 13 likewise is patentable over Young or Muise in view of Flanagan, Bullock, and Day, and further in view of Corrugated Common Footprint.

Additionally, Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. Obviousness cannot be established by merely suggesting that it would have been obvious to one of ordinary skill in the art to modify Young or Muise with Flanagan, Bullock, Day, and Corrugated Common Footprint. As explained by the Federal Circuit, “to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Applicant.” In re Kotzab, 54 USPQ2d 1308, 1316 (Fed. Cir. 2000). MPEP 2143.01.

Furthermore, as is well established, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 221 U.S.P.Q.2d 1125 (Fed. Cir. 1984). Furthermore, the Federal Circuit has determined that:

[I]t is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” In re Fitch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

Further, under Section 103, “it is impermissible . . . to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” In re Wesslau, 147 USPQ 391, 393 (CCPA 1965). Rather, there must be

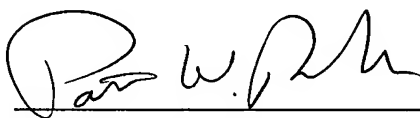
some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants' disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to combine the cited art, nor any reasonable expectation of success has been shown.

Accordingly, since there is no teaching nor suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection of Claim 13 be withdrawn.

For at least the reasons set forth above, Applicants respectfully request that the 35 U.S.C. §103(a) rejection of Claim 13 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in the application are believed to be in condition for allowance. Favorable action is respectfully solicited.

Respectfully submitted,



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